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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/354,608	07/16/1999	YASUHIRO YAMANAKA	SONYJP-3.0-0	5368
530	7590	12/15/2003	EXAMINER	
LERNER, DAVID, LITTENBERG, KRUMHOLZ & MENTLIK 600 SOUTH AVENUE WEST WESTFIELD, NJ 07090			ABDI, KAMBIZ	
			ART UNIT	PAPER NUMBER
			3621	

DATE MAILED: 12/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/354,608

Applicant(s)

YAMANAKA, YASUHIRO

Examiner

Kambiz Abdi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-51 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. The text of those sections of Title 35, U.S. Code not included in this section can be found in the prior office action.

2. The prior office actions are incorporated herein by reference. In particular, the observations with respect to claim language, and response to previously presented arguments.

- Claims 1, 3-6, 10, 12-16, 19, and 21-25 are amended.
- Claims 1-51 are pending.

Response to Arguments

3. Applicant's arguments filed 10 October 2003 have been fully considered but they are not persuasive for the following reasons:

In response to applicant argument regarding rejection of Claims 1, 10, 19, 28, and 40 under 35 U.S.C. § 102 as being anticipated by Nuttall.

4. The examiner believes that the argument that the applicant has put forward on regards to claim 1 is not persuasive to overcome the prior art of record. As the applicant has clearly stated the fact that Nuttall clearly can be understood as having a server side and a requesting side that are geographically remote from one another. As it is obvious to one of ordinary skill in the art it could easily be inferred from Nuttall teaching that all the components can be located or even be part of the same system on a single "Bus". Therefore the applicant's contention that requesting node is geographically separate from the distribution facility is moot.

5. As for the communications among the requesting node and distribution facility it might not be clear to the applicant as what Nuttall is trying to achieve. Nuttall is clear that a request is sent to content providing node 108. Applicant seems to have overlooked the fact content providing node is in direct communication with authorizing node, which in turn is directly in bi-directional communication with content managing node. It could even be clear to one of ordinary skill in the art that all of the authorizing, managing, providing nodes be in the one server functioning as one unit in direct bi-direction or multidirectional communication with the banking node (See figure 3). The fact that

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components are separate does not make the claim steps inventive. See *In re Dulberg*, 289 F.2d 522, 523, 129 USPQ 348, 349 (CCPA 1961). (The claimed structure, a lipstick holder with a removable cap, was fully met by the prior art except that in the prior art the cap is "press fitted" and therefore not manually removable. The court held that "if it were considered desirable for any reason to obtain access to the end of [the prior art 's] holder to which the cap is applied, it would be obvious to make the cap removable for that purpose."). Also, see *In re Larson*, 340 F.2d 965, 968, 144 USPQ 347, 349 (CCPA 1965) *Schenck v. Nortron Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983)

6. Applicant puts forward the argument that no copyright information is stored at the content providing node. On the contrary if the same rational as above is relied upon one skilled in the art at the time of the invention clearly would point out that content information is stored at content providing node as it is clearly marked in figure 3 as "map files" and content files. As it is clear the content files are related to requester's information as well as other information related to the content and stored in an storage area. At the same time if one notices in figure 3 clearly the content providing node and content requesting node are on both sides of the content managing, authorizing, and banking nodes. It clearly shows that the content providing node could be part of one unified server system that is remote from content requesting node.

7. Additionally the examiner would like to bring the attention of the applicant to the fact, that if some of the elements of system in Nuttal are in more than one node, that does not mean that the combination of these elements on separate nodes would not function as one unit in another system as it has been claimed in claim 1, 10, 19, 28, and 40. The examiner would like to further expand on the functions of the nodes in Nuttal. All the steps that take place in claimed invention does take place in the Nuttal system as well. It is only that Nuttall uses more elements than the applicant's system comprises of, as the applicant has admitted to and considers it "a complicated system". Otherwise the communication and component elements of the system of Nuttal are the same as the applicant's. The mere fact the applicant's system elements are on a different side than the prior art of record, does not distinguish the applicant's claimed invention from the prior art of the record.

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8. Therefore, the current examiner maintains the previous rejection of the claimed invention as they have been amended and presented in their current form.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 1, 4 – 10, 13 – 19, 22 – 29, 36 – 41 and 48 – 51 are rejected under 35 U.S.C. 102(e) as being anticipated by Nuttall.

11. Regarding claims 1, 6, 10, 15, 19 and 24:

Nuttall teaches a method for computer network operation providing basis for usage fees such that Applicant's copyright information storage means for storing copyright information related to the copyrighted works, said copyright information including the identities of the copyrighted works, the identities of the owners of the copyrights for the copyrighted works and data related to the costs for downloading the copyrighted works at said receiving side **reads on** content providing node, element 108 and figure 14,

Applicant's receiving means for receiving downloading information sent from the receiving side, said downloading information identifying selected copyrighted works distributed from the distribution side and downloaded at said receiving side, indicating that said receiving side's downloading of said selected copyrighted works was authorized, and indicating that an accounting has occurred for said receiving side's payment for said downloading **reads on** authorizing node, element 112, content requesting node, element 110 and the permit, column 4, lines 16 – 22,

and Applicant's copyright management means for performing copyright management related to the copyright for each selected copyrighted work in response to said downloading information and based upon said downloading information and the copyright information, said copyright management including calculating a copyright payment due each owner of the copyrights for the selected copyrighted works **reads on** reconciling node, element 118.

12. Regarding claims 4, 5, 13, 14, 22 and 23:

Applicant's customer management center reads on authorizing node 112, page 2, paragraph [0035].

13. Regarding claims 7, 16, 25, 38 and 50:

Nuttall teaches that the content is encrypted, step 1210 of figure 12. See also page 4, paragraph [0051].

14. Regarding claims 8, 17 and 26:

Nuttall discloses using satellite communications.

15. Regarding claims 9, 18, 27, 37 and 49:

Nuttall discloses that the content/work can be music, page 3, paragraph [0038].

16. Regarding claims 28, 29, 36, 40, 41 and 48:

Applicant's server adapted to serve said copyrighted works through a first transmission system to a receiving facility **reads on** the content providing node 108 and element 148.

Applicant's communication interface adapted to receive through a second transmission system downloading information, said downloading information identifying selected copyrighted works downloaded by said receiving facility, indicating that said receiving facility's downloading of said selected copyrighted works was authorized and indicating that an accounting has occurred for said receiving facility's payment for said downloading **reads on** content providing node, element 108 and 136, authorizing node, element 112, content requesting node, element 110 and the permit, column 4, lines 16 – 22,

Applicant's memory adapted to store copyright information corresponding to each of said copyrighted works, said information providing the identity of the copyrighted work, the identity of the

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owner of the copyright for the copyrighted work and data relating to the cost for downloading the copyrighted work by said receiving facility **reads on** the various reports generated by the nodes and stored in memory, figures 17 - 20, and

Applicant's processor, in communication with said memory and said communication interface, adapted to calculate, in response to said downloading information and on the basis of said downloading information and said copyright information, a copyright payment due each owner of the copyrights for the selected copyrighted works **reads on** reconciling node, element 118.

17. Regarding claims 39 and 51:

See pages 2 - 3, paragraph [0035].

18. Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

Claim Rejections - 35 USC § 103

19. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

20. Claims 30, 31, 42 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nuttall.

Regarding claims 30 and 42:

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Although Nuttall does not specifically teach that the content providing node, element 108 (server) serves through a first transmission system and the content providing node, element 108 (communication interface) receives through a second transmission system, Nuttall does disclose that Satellite communications is possible. Therefore, it is considered that it would have been obvious to one of ordinary skill in the art at the time of the invention to, for instance, receive a request for content via the internet, from a user, and for the content provider to provide the content (video) via a satellite transmission system as this method is old and well known and Nuttall discloses that satellite communication is one possible method, page 2, paragraph [0029].

Regarding claims 31 and 43:

While Nuttall does not specifically disclose a copyright fee "ratio", it is considered that it would have been obvious, if not inherent, to use a fee "ratio" as most fees/costs are based on some type of profit margin which can be illustrated as a ratio.

21. Claims 2, 3, 11, 12, 20, 21, 32 – 35 and 44 - 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nuttall in view of Schein et al.

While Nuttall does not specifically disclose how video content may be selected by a user, Schein et al teach video content ordering wherein Applicant's program identification information, where said program identification information including the identity of a television program featuring broadcasted copyrighted works transmitted from said distribution side, the identities of said broadcasted copyrighted works, a broadcasting time for said television program and the identities of channels on which said broadcasted copyrighted works are transmitted, and wherein said copyright management means also performs said copyright management based upon said program identification information is taught. Therefore, it is considered that it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Nuttall to include television programs as a content selection, as taught by Schein et al, as Nuttall does disclose video transmission capability, and including television programs would only increase the profits to be earned by Nuttall's content provider.

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22. Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

Conclusion

1. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kambiz Abdi whose telephone number is (703) 305-3364. The examiner can normally be reached on 9:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell can be reached on (703) 305-9768.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703)308-1113.

Any response to this action should be mailed to:

**Commissioner of Patents and Trademarks
Washington, D.C. 20231**

or faxed to:

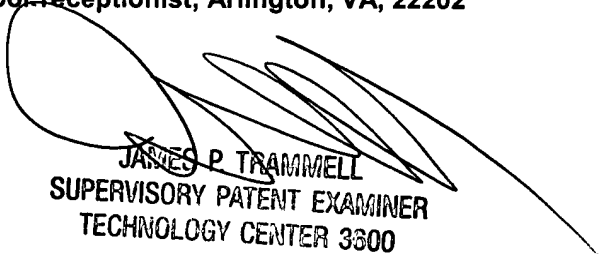
(703) 872-9306 [Official communications; including After Final communications labeled "Box AF"]

(703) 746-7749 [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to:

**Crystal Park 5, 2451 Crystal Drive
7th floor receptionist, Arlington, VA, 22202**

**Abdi/K
December 10, 2003**


**JAMES P. TRAMMELL
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600**